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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,993	05/11/2005	Gerard Hayes	TOMK:015	7267
37013 7590 04/22/2008 ROSSI, KIMMS & McDOWELL LLP. P.O. BOX 826 ASHBURN, VA 20146-0826				
EXAMINER				
DOUGLAS, STEVEN O				
ART UNIT		PAPER NUMBER		
3771				
MAIL DATE		DELIVERY MODE		
04/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,993

Applicant(s)

HAYES ET AL.

Examiner

/Steven O. Douglas/

Art Unit

3771

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9,11 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9,11 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

Figures 1-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4-7,9,11,20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Strater'572.

The Strater'572 reference discloses a device dispensing small amounts of fluid (the characteristic of the fluid is such that it is viscous in nature, see col. 1, lines 11-14, which certainly be capable of blocking tar and nicotine) comprising a squeeze container 10 and a readily replaceable delivery feature 16 (see also col. 2, lines 25-38). All functional and introductory statements of intended use have been considered but are deemed not to impose any

structure on the claims distinguishable over the Strater device which is further capable of being used to dispense fluid to distributed zone of a smoking article.

In regard to claim 4 and 20, the delivery feature is capable of being disposed of after as few as a single use and applicant's limitation of a kit does not distinguish over the Strater device which is capable of being merchandised as a kit.

In regard to claim 9, the delivery feature or needle 16 is of the size to reach a region proximate the base of a filter as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13,14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strater in view of Riccio '010.

The Strater reference discloses a dispensing apparatus (supra), but does not disclose the container as including a spring loaded piston/cylinder unit with associated non-return valve. The Riccio reference discloses another dispensing apparatus having a container 32 (see Fig. 1) with an associated piston/cylinder unit and non-return valves. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a container as, for

example, shown by Riccio for the container of Strater, wherein so doing would amount to the mere substitution of one type of dispensing container for another that would work equally as well.

Claims 13-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strater in view of Santeramo'178.

The Strater reference discloses a dispensing apparatus (supra), but does not disclose the container as including a piston/cylinder unit with associated graduated markings. The Santeramo reference discloses another dispensing apparatus having a container 11 with an associated piston/cylinder unit and graduated markings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a container as, for example, shown by Santeramo for the container of Strater, wherein so doing would amount to the mere substitution of one type of dispensing container for another that would work equally as well.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen'015 et al. in view of Strater.

The Rosen et al. reference discloses a kit for dispensing a liquid fluid to a smoking article including a container (see fig. 5), but does not disclose a multiplicity of disposable delivery features. The Strater reference discloses another dispensing container with a multiplicity of disposable delivery features discussed supra (i.e. needles 16) so as to accommodate dispensing a controlled quantity of fluid to an exact (or hard to reach) location. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to include a multiplicity of disposable delivery features in view of the teachings of the Strater reference to accommodate dispensing a controlled quantity of fluid to an exact (or hard to reach) location.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strater in view of Mueller'100.

The Strater reference discloses a dispensing apparatus (supra), but does not disclose the container as including a metering valve or a spring-based fluid release feature. The Mueller reference discloses another squeeze-type dispensing container having a spring-based fluid metering valve 124 (see Fig. 11) to facilitate precise metering of fluid from the container. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Strater container to have a spring-based fluid release or metering valve in view of the teachings of the Mueller'100 reference to facilitate the precise metering of fluid from the container.

If applicant takes issue over the viscous fluid of Strater'572 not being sufficient to block the tar and nicotine of a smoking article, an alternative rejection is as follows:

Claims 1,2,4-7,9,11,20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strater'572 in view of Rosen'015 et al.

The Strater'572 reference discloses a device dispensing small amounts of fluid (the characteristic of the fluid is such that it is viscous in nature, see col. 1, lines 11-14) comprising a squeeze container 10 and a readily replaceable delivery feature 16 (see also col. 2, lines 25-38).

All functional and introductory statements of intended use have been considered but are deemed not to impose any structure on the claims distinguishable over the Strater device which is further capable of being used to dispense fluid to distributed zone of a smoking article.

In regard to claim 4 and 20, the delivery feature is capable of being disposed of after as few as a single use and applicant's limitation of a kit does not distinguish over the Strater device which is capable of being merchandised as a kit.

In regard to claim 9, the delivery feature or needle 16 is of the size to reach a region proximate the base of a filter as claimed.

The Strater reference fails to explicitly disclose the fluid as being sufficiently viscous to block tar and nicotine of a smoking article. The Rosen reference discloses another viscous fluid dispenser arranged to dispense a sugar-based syrup (see col. 1, lines 1-30) to block tar and nicotine in a smoking article. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Strater device to handle a fluid such as one disclosed by Rosen et al. in view of the teachings of the Rosen et al. reference to treat a smoking article to block tar and nicotine from being inhaled by a user.

Claims 13,14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strater in view of Rosen et al. (as applied above) and further in view of Riccio '010.

The Strater reference discloses a dispensing apparatus (supra), but does not disclose the container as including a spring loaded piston/cylinder unit with associated non-return valve. The Riccio reference discloses another dispensing apparatus having a container 32 (see Fig. 1) with an associated piston/cylinder unit and non-return valves. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to substitute a container as, for example, shown by Riccio for the container of Strater, wherein so doing would amount to the mere substitution of one type of dispensing container for another that would work equally as well.

Claims 13-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strater in view of Rosen et al. (as applied above) and further in view of Santeramo'178.

The Strater reference discloses a dispensing apparatus (*supra*), but does not disclose the container as including a piston/cylinder unit with associated graduated markings. The Santeramo reference discloses another dispensing apparatus having a container 11 with an associated piston/cylinder unit and graduated markings. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a container as, for example, shown by Santeramo for the container of Strater, wherein so doing would amount to the mere substitution of one type of dispensing container for another that would work equally as well.

Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strater in view of Rosen et al. (as applied above) and further in view of Mueller'100.

The Strater reference discloses a dispensing apparatus (*supra*), but does not disclose the container as including a metering valve or a spring-based fluid release feature. The Mueller reference discloses another squeeze-type dispensing container having a spring-based fluid metering valve 124 (see Fig. 11) to facilitate precise metering of fluid from the container. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify Strater container to have a spring-based fluid release or metering valve in view of the teachings of the Mueller'100 reference to facilitate the precise metering of fluid from the container.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Steven O. Douglas/ whose telephone number is (571) 272-4885. The examiner can normally be reached on Mon-Thurs 6:30-5:00.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven O. Douglas/
Primary Examiner
Art Unit 3771

SD
4/18/08